

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said talus bone" in lines 6 and 7. There is insufficient antecedent basis for this limitation in the claim.

Again, applicant understands and apologizes to the examiner for the lack of explanation and antecedent basis for amended claim 1 as it was inadvertent. Applicant has amended claim 1 to recite each bone of the midfoot region into which the device is inserted beginning from the metatarsal bone and subsequently toward and into the medial cuneiform bone, into and through the navicular bone and finally inserted into the talus bone to stabilize the midfoot region. Claim 2 has been cancelled and claims 3-9 are dependent on claim 1 or subsequent dependent claims.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schon et al. (U.S. Publication No. 2003/0097131).

Schon et al. disclose an intramedullary nail (4) having a proximal end, a distal end and a central cylindrical elongated body with a chamfered end and at least one slot (32) where said device comprises an attaching means to a bone. Said intramedullary nail is cannulated (see Figure 2) comprising a round cross-section with a central elongated body. The intramedullary nail is adapted with said attaching means by way of a proximal fastener hole (48) and a distal fastener hole (16) where a fastener (50) is inserted into at least one of the fastener holes. Said fastener is configured and dimensioned for insertion in at least one of said fastener holes, further comprising a threaded hole for insertion of a screw.

With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Schon et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458,459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d

1647 (1987). Additionally, it would have been an obvious matter of design choice to have created the nail to be of a smaller size to fit a human foot versus an elephant's foot, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Schon et al. disclose the claimed limitations except for the chamfered end being defined by a reduction in diameter by a 45 degree chamfer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have created the device of Schon et al. by a 45 degree chamfer, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection. The amendments filed on June 7, 2010 overcome the Schon et al. reference as a 102 (e) reference but do not overcome the reference as a 103 (a) as seen above. The only differences in the amendments made were that a 45 degree chamfer is required. As seen in the reference Schon et al. disclose a chamfer but is lacking in the actual angle of the chamfer. Therefore a 102 (e) anticipation is not appropriate.

As stated in the interview that took place on February 18, 2010, it is still recommended to further define the structure of the device.

Applicant understands the examiner's arguments and thanks examiner for understanding that the 35 USC 102 (e) anticipation is no longer valid. Applicant has now also fully amended claim 1 to describe each essential element of the device necessary for securing the midfoot region and detailing exactly how that device is inserted into and through each of the bone of the midfoot region into which the device is inserted beginning from the metatarsal bone and subsequently toward and into the medial cuneiform bone, into and through the navicular bone and finally inserted into the talus bone to stabilize the midfoot region. Applicant respectfully states that, based on the now amended claim 1 and all subsequent dependent claims (3-9) that the device of Schon neither teaches nor suggests the same or similar device as required for stabilization of the midfoot region as provided by the present application and invention.

CLAIMS LISTING:

Claim 1 (Currently amended)

Claim 2 (Cancelled)

Claims 6-9 (Currently amended)

Claims 10-20 (Cancelled)